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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,200

08/30/2006

George Philip Lahm

BA9332USPCT

7400

7590

02/27/2009

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EXAMINER

BROWN, COURTNEY A

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

02/27/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,200	<b>Applicant(s)</b> LAHM ET AL.	
	<b>Examiner</b> COURTNEY BROWN	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/16/2007</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-15 are pending and are being examined for patentability.

### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. This application is a 371 of PCT/US05/12465 filed April 12, 2005. Applicant claims benefit to U.S. Provisional Application No. 60/561,813 filed April 13, 2004.

### ***Information Disclosure Statement***

The Information Disclosure Statement (IDS) submitted on February 16, 2007 been considered by the examiner.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 12, 13, and 22 of U.S. Patent No. 6,747,047 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed subject matter embraces or is embraced by US Patent 6,747,047 B2 ("047 ").

Instant claims 1,3, and 7 and patented claims 1,3,12,13, and 22 are both directed to compound of instant Formula 1, a composition comprising said compound, and a method for controlling pests comprising contacting said pests or their environment with an effective amount of said compound. The difference between the invention of the instant application and that of US Patent 6,747,047 B2 is that the instant invention is used to control invertebrate pest as opposed to arthropods. It is known to one of ordinary skill in the art that invertebrate pest such as spiders belong to the Arthropoda phylum. From this extensive overlap of subject matter, one of ordinary skill in the art would recognize that the same product is produced in US Patent ("047 ").

Claims 1, 3, and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 17, and 19 of copending Application No. 11/700,584. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed subject matter embraces or is embraced by co-pending application 11/700,584.

Instant claims 1,3, and 7 and copending claims 1,3,12,13, and 22 are both directed to compound of instant Formula 1, a composition comprising said compound, and a method for controlling pests comprising contacting said pests or their environment with an effective amount of the aforementioned compound. From this extensive overlap of subject matter, one of ordinary skill in the art would recognize that the same product is produced in copending application 11/700,584.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3, and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 12/141170. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed subject matter embraces or is embraced by co-pending application 12/141170.

Instant claims 1,3, and 8 and copending claims 1 and 2 are both directed to a method for controlling pests comprising contacting said pests or their environment with an effective amount of the compound of instant Formula 1. The difference between the invention of the instant application and that of co-pending application 12/141170 is that the instant invention is for the control of invertebrate pests as opposed to lepidopteran, homopteran, hemipteran, thysanopteran, and coleopterian pests. It is known to one of ordinary skill in the art that lepidopteran pest is an order of insect that includes moths and butterflies which are both considered to be invertebrates. From this extensive

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overlap of subject matter, one of ordinary skill in the art would recognize that the same product is produced in copending application 12/141170.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

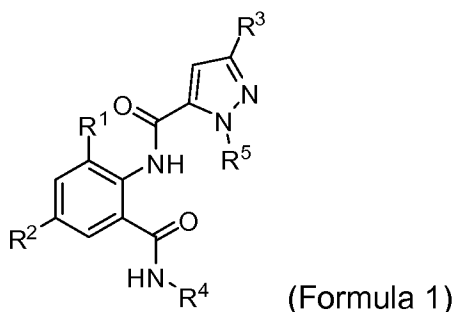
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lahm et al. (WO 01/70671 A2) in view of Lahm et al. (US Patent Application 2004/0063738 A1).**

***Applicant's Invention***

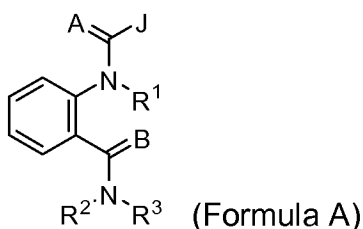
Applicant claims a compound of Formula 1, an N-oxide or a salt thereof



wherein R1 is Me, C1, Br or I; R2 is -CN; R3 is C1, Br, CF3, OCH<sub>2</sub>CF<sub>3</sub> or OCF<sub>2</sub>H; R4 is H; or C1-C4 alkyl, C2-C4 alkenyl or C2-C4 alkynyl, each optionally substituted with CN or SMe; and R5 is phenyl substituted with 1 to 3 substituents selected from the group consisting of F, C1, Br and Me. Applicant also claims a method and composition (in the form of a soil drench formulation, a spray composition, and a bait composition) for controlling an invertebrate pest comprising the use of the aforementioned compound of Formula 1.

***Determination of the scope and the content of the prior art  
(MPEP 2141.01)***

Lahm et al. teach compounds of Formula (A) (see below), their N-oxides and agriculturally suitable salts, methods for controlling arthropods comprising contacting the arthropods or their environment with an arthropodically effective amount of a compound of Formula (A), and compositions containing the compounds of Formula (A) (abstract).



Specifically, Lahm et al. teach the compound of Formula A wherein A and B is O; J is a 5-membered heteroaromatic ring (i.e. pyrazole) optionally substituted with 1 to 4 R<sub>7</sub>; R<sub>7</sub> is a phenyl that is optionally substituted with one to three substituents independently with a halogen group; R<sub>1</sub> is H; R<sub>2</sub> and R<sub>3</sub> is H, C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>2</sub>-C<sub>6</sub> alkenyl, or C<sub>2</sub>-C<sub>6</sub> alkynyl and R<sub>4</sub> is independently H, C<sub>1</sub>-C<sub>6</sub> alkyl or CN; provided that:

- (i) at least one R<sub>4</sub> and at least one R<sub>7</sub> are other than H ;
- (ii) J is other than an optionally substituted 1, 2, 3-thiadiazole ; and
- (iii) when J is an optionally substituted pyrazole, tetrazole or pyrimidine, then R<sub>2</sub> and R<sub>3</sub> cannot both be hydrogen (see pages 4-7 of Lahm et al. and the compound of instant Formula 1 wherein R<sub>1</sub>= Me; R<sub>2</sub>=CN;R<sub>3</sub>=Cl or Br; R<sub>4</sub>=H; or C<sub>1</sub>-C<sub>4</sub> alkyl orC<sub>2</sub>-C<sub>4</sub> alkenyl; and R<sub>5</sub>= phenyl substituted with 1 to 3 substituents selected from the group consisting of F,Cl.Br, and Me, claims 1 and 2 of instant application). Lahm et al. teach



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a composition comprising the active Formula A preferably combined with at least one biologically active compound selected from the group consisting of cyhalothrin, beta-cyfluthrin, esfenvalerate, methomyl, imidacloprid, thiacloprid, indoxacarb, abamectin, endosulfan, fipronil, flufenoxuron, pyriproxyphen, pymetrozine, amitraz, *Bacillus thuringiensis*, and *Bacillus thuringiensis delta endotoxin* (see page 166, lines 3-15, claims 3-6 of instant application). Lahm et al. teach a method for the control of foliar and soil inhabiting arthropods and nematode pests and protection of agronomic and/or nonagronomic crops, comprising applying one or more of the compounds of Formula A or compositions containing at least one such compound, in an effective amount, to the environment of the pests including the agronomic and/or nonagronomic locus of infestation, to the area to be protected, or directly on the pests to be controlled (page 166, lines 23-29, claims 7 and 8 of instant application). Lahm et al. teach spraying as a preferred method of application as well as other methods including direct and residual sprays, aerial sprays, seed coats, microencapsulations, systemic uptake, baits, eartags, boluses, foggers, fumigants, aerosols, and dusts (page 166, lines 29-33, claims 10 and 14 of instant application). Lahm et al. teach that the compounds of Formula A can be incorporated into baits that are consumed by the arthropods or in devices such as traps and the like (page 166, lines 33 and 34, claim 15 of instant application). Lahm et al. teach formulations comprising one or more compounds of Formula A combined with suitable carriers, attractants, diluents, and surfactants and possibly in combination with food (page 166, lines 35-38, claim 3 of instant application). Lahm et al. teach that the compounds of Formula A exhibit activity against a wide spectrum of foliar-feeding, fruit-

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feeding, stem or root feeding, seed-feeding, aquatic and soil-inhabiting arthropods including the German cockroach (page 164, line 16) and pests of the Orders Hymenoptera (i.e. ant, wasps and sawflies, page 164, line 2, claims 9 and 10 of instant application).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

The difference between the invention of the instant application and that of Lahm et al. is that the instant invention claims a method wherein the composition comprising instant Formula 1 is in the form of a soil drench liquid formulation as opposed to being silent. For this reason, the teaching of Lahm et al.('738) is joined. Lahm et al. teach the use a soil drench of a liquid formulation ([0267]) comprising a composition for controlling invertebrate pest such as ants, wasps, and cockroaches ([0259]).

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the two cited references to arrive at a method for controlling an invertebrate pest comprising the use of the aforementioned compound of Formula A (Formula 1 of instant application) in a soil drench liquid formulation. Both references teach active compounds that are used to control pest commonly found in the

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soil. One would have been motivated to make this combination in order to receive the expected benefit of having a method of introducing the claimed active compound of instant Formula 1 directly into the pest's habitat (i.e., soil). Thus, in view of *In re Kerkhoven*, 205 USPQ 1069 (C.C.P.A. 1980), it is *prima facie* obvious to combine two or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art.

Therefore, the claimed invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because every element of the invention has been fairly suggested by the cited reference.

None of the claims are allowed.

### ***Conclusion***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electron Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Technology Center 1600  
Group Art Unit 1616

/Mina Haghighatian/  
Primary Examiner, Art Unit 1616